

REMARKS/ARGUMENTS

This Application has been carefully reviewed in light of the Office Action mailed March 7, 2007. Claims 1-70 are pending in this Application. Claims 23-42 and 56-70 have been withdrawn without prejudice. Examination has been limited to Claims 1-8 and 15-22 (Office Action, p. 2) based on the characterization of Species 1A in the Office Action dated January 18, 2007. Independent Claims 1, 18, 20 and 21 have been amended. Claim 2 has been canceled. New independent Claim 71 is presented.

Amendments to the Claims

Claims 1 and 18 have been amended to incorporate the feature of Claim 2, now canceled. Claims 3 and 5 have been amended to reflect changes in their dependency to amended independent Claim 1 from Claim 2. Claims 20 and 21 have been amended to reflect proper antecedent basis. New independent Claim 71 has been added.

Claim Objections under 35 U.S.C. § 112

The Office has objected to Claims 20 and 21 because they lack antecedent basis for not defining “face” and “back” of the product where products are stacked “face-to-back” (Claim 20) and “face-to-face” or “back-to-back” (Claim 21). (Office Action, p.3). Claims 20 and 21 have amended to clarify the front and the back. The amendment is believed to be supported by at least paragraphs [0005] and [0042] of the specification.

Claim Rejections under 35 U.S.C. § 102 (e)

In the Office Action, Claims 1, 2, 6-8, 18 and 22 are rejected under 35 U.S.C. § 102 (e) as being anticipated U.S. Patent No. 6,949,160 granted to Weiss (“Weiss”).

Independent Claims 1 and 18 have been amended to provide that the protective layer is adhered specifically with an adhesive to the finish layer. The Office provides at page 4 of the Office Action that “the protective layer is adhered to the finish with an adhesive (the fact that the layer is adhered to the product means an adhesive is involved)”. However, it is not at all clear that Weiss discloses that a protective layer is adhered to a finish layer with an adhesive. Applicant respectfully submits that Weiss does not teach the use of an adhesive to adhere the protective layer to the finish layer. At best, it appears that Weiss discloses an “adhesion

promoter” (Col. 14: 56-66) for addition to protective layer-forming materials that “improve the adhesion of the film to the painted surface” (Col. 14: 55-57) and therefore substantively and qualitatively affects the nature of the protective film itself. Unlike amended Claim 1, Weiss does not appear to teach a separate adhesive that adheres a protective layer to a finish layer. Furthermore, Weiss also does not teach that when the protective layer is removed, no residue remains. Accordingly, Applicant respectfully submits that because Weiss does not teach all the elements of amended Claim 1, Weiss does not anticipate amended Claim 1. And because Weiss fails to anticipate Claim 1, it also fails to anticipate dependent Claims 2, 6-8, 18 and 22.

Thus, Applicant respectfully requests that the rejection of Claims 1, 2, 6-8, 18 and 22 be withdrawn.

Claim Rejections under 35 U.S.C. § 103 (a)

Rejection of Claims 15-17 and 19-21

In the Office Action, Claims 15-17, and 19-21 were rejected under 35 U.S.C. § 103 (a) as being obvious in view of Weiss. (Office Action, p. 5). Applicant respectfully traverses these rejections. The rejections are addressed in the order in which they were presented in the Office Action.

Claims 15-17 depend from independent Claim 1. Regarding Claims 15-17, the Office states that Weiss does not disclose the limitations on thickness, but argues that it would have been a design choice to one of ordinary skill in the art absent any showing of criticality. First, Applicant respectfully submits that Claims 15-17 which depend from Claim 1, as amended, are not obvious in view of Weiss for at least the reasons indicated above. Second, as Examples 2-4 of Table 1 (p. 17) of the specification of the Application shows, the thickness of the protective layer is important. For instance, shown in Example 1, a protective layer having a thickness of 2.5 mils burnishes and creates an uneven gloss of the finish layer and was found to be unsuitable. In contrast, a protective layer having a thickness less than 2.5 does not burnish the finish and the gloss does not become uneven. Consequently, the thickness of the protective layer is more than merely a design choice.

Claims 19-21 depend from independent Claim 18. Regarding Claim 19, the Office states that Weiss discloses the claimed invention including that the products are stacked, but not on a pallet although it would have been obvious to do so. Applicant respectfully submits that the Office has not shown that the claimed invention is *prima facie* obviousness, particularly in view

of independent Claim 18, as amended. A *prima facie* case of obviousness is established only where there is a suggestion or motivation to modify the reference to teach or suggest all the claim limitations. *see. M.P.E.P. § 2143.* As discussed previously, Weiss does not teach or suggest the features of Claim 19 recited in independent Claim 18, specifically, “a protective layer adhered with an adhesive to the finish layer...”. Applicant respectfully submits that Weiss does not teach the stacking of a product having the combination of these limitations and thus does not render Claim 19 obvious.

Regarding Claims 20 and 21, they are not obvious for the same reasons recited for Claim 19.

Applicant respectfully requests that the rejection of Claims 15-17, and 19-21 be withdrawn.

Rejection of Claims 3-5

Claims 3-5 are rejected under 35 U.S.C. § 103 (a) as being obvious over Weiss in view of U.S. Pat. No. 6,599,599 (“Buckwater”). (Office Action, p. 6). Applicant respectfully traverses this rejection.

Regarding Claims 3 and 4, the Office states that “Weiss discloses the claimed invention except that the adhesive is an ethylene acrylic acid. Buckwater discloses a product (Fig. 1) with a removable layer (20) and an adhesive layer (18) of ethylene acrylic acid (Column 4, lines 64).”

Weiss discloses an “adhesion promoter” (Col. 14: 56-66) for addition to protective layer-forming materials “to improve the adhesion of the film to the painted surface” (Col. 14: 55-57) and therefore substantively and qualitatively affects the nature of the protective film, as mentioned above. Unlike Claim 1, as amended, Weiss does not teach the adhesion of a protective layer with an adhesive to a finish layer.

Buckwater provides an underlayment assembly that “eliminates the need for on-site adhesive application,” (col. 4, line 27), that has an underlayment with a “pressure sensitive adhesive layer 18 pre-applied” to its upper surface, and “a release layer 20 disposed on the adhesive layer 18.” (col. 4, lines 27-33). In another embodiment, shown in Figure 2, an underlayment assembly is provided where the lower surface of the underlayment is coated with a second adhesive layer to enhance attachment of the underlayment to a structural support member, such as floor, to mitigate creaking. (col. 4, lines 33-44). The remaining embodiments are similar.

Applicant respectfully submits that the Office has not shown a desire to combine Weiss and Buckwater and therefore the Office has not demonstrated the requisite suggestion or motivation to combine the references. M.P.E.P. 2143.02. It is not at all clear why one of ordinary skill would desire to add an adhesive of Buckwater to “use this adhesive to adhere the protective layer to the product in Weiss to insure that the layer did not unexpectedly remove itself,” (Office Action, p. 7), since the Buckwater adhesives are specifically desired to leave a residue, *exactly* contrary to independent Claim 1, from which Claims 3-5 depend, that “the protective layer leaves no residue” (emphasis added). Applicant thus respectfully submits that the Office has not made a proper showing in support of a *prima facie* case of obviousness. M.P.E.P. § 2143.

Furthermore, the combination of Weiss and Buckwater teaches away from the invention. Whereas Buckwater contemplates the enduring presence of the adhesive on a product to “eliminate[] the need for on-site adhesive application” so that the adhesive will support the attachment of the underlayment to a structural support. Claim 1, from which Claim 3 depends, instead, specifically recites that “remov[al] of the protective layer leaves no residue on the finish layer.” Claim 1 further recites that the adhesive “does not damage the finish layer” after the protective layer is removed. In contrast, the adhesive in the Buckwater underlayment assembly is desired to remain for adhering the product to the structural support. It is not contemplated to be removed, and most certainly not for being removed without damaging the protective layer recited in Claim 1. In fact, Buckwater discloses only that a finished layer such as flooring may be attached to the adhesive layer only after removal of the “release layer”. It does not disclose a protective layer adhered to a finished layer. One of ordinary skill, considering the teaching of Buckwater, would actually expect that the adhesive’s removal given its purpose would damage any surface to which it was bonded.

Thus, Applicant respectfully submits that one of ordinary skill in the art would not expect a reasonable likelihood of success of using the adhesive of Buckwater *contrary to its teaching* to (1) adhere a protective layer to a finish layer that (2) when removed “leaves no residue” on a finished layer. Accordingly, the Office has not made a requisite showing in support of a *prima facie* case of obviousness. M.P.E.P. § 2143.

Thus, Applicants respectfully request that the rejection of Claims 3-5 be withdrawn.

New Claim

Claim 71 is newly presented and is believed to be patentably distinguishable over Weiss. Claim 71 recites a multilayer protective film comprising at least one adhesive layer that adheres the film to the recited finish layer. In contrast, Weiss discloses a single-layer protective film. (E.g., Col. 8, lines 52-53; Col. 10, lines 15-19; Col. 10, lines 56-58; Col. 11, lines 9-11; Col. 12, lines 44-48). Claim 71 finds support in the specification, at least, at paragraphs [0034], [0036], and [0037].

CONCLUSION

Applicants respectfully submit that the Application is in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

No fees are believed due, however, Applicants hereby authorize the Commissioner to charge any additional fees or refunds that may be required by this paper to Gardere Wynne Sewell LLP Deposit Account No. 07-0153. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to Gardere Wynne Sewell LLP Deposit Account No. 07-0153.

Please direct all correspondence to the practitioner listed below at Customer No. 60148.

Respectfully submitted,



June 6, 2007

Scott C. Sample
Registration No. 52,189
Gardere Wynne Sewell LLP
Thanksgiving Tower
1601 Elm Street, Suite 3000
Dallas, Texas 75201-4761
Telephone: 214.999.4712
Facsimile: 214.999.3712
Email: ssample@gardere.com